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09/925,825	08/10/2001	Clarence J. Link Jr.		6973

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MCAFEE & TAFT  
TENTH FLOOR, TWO LEADERSHIP SQUARE  
211 NORTH ROBINSON  
OKLAHOMA CITY, OK 73102

EXAMINER

DOUGLAS, STEVEN O

ART UNIT

PAPER NUMBER

3751

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 9

Application Number: 09/925,825

Filing Date: August 10, 2001

Appellant(s): LINK JR., CLARENCE J.

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Neal R. Kennedy  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4-28-03.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 48-86 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 48-86 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Accordingly, during the prosecution of S.N 09/054,221 the original claims 1-47 included the explicit limitations with respect to transmission and clutch controls (see claims 1 and 19) and the claims were allowed based on these explicit limitations (*see the reasons for allowance in paper #3, which Applicant failed to contest after receiving paper #3*). Therefore, *Applicant surrendered the subject matter with respect to the transmission and clutch controls during the prosecution of the 09/054,221 application and such subject matter should be included in the newly proposed reissue claims 48-86.*

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**(11) Response to Argument**

Appellant's arguments filed 4-28-02 have been fully considered but they are not persuasive. In regard to Appellant's argument that Examiner improperly rejected the claims under 35 USC 251, with respect to the application of the **RECAPTURE** doctrine (see page 9, line 19 through page 14, line 18 of Appellant's brief), Examiner disagrees with Appellant, in that since Appellant did not amend the claim language before Examiner issued the claims (i.e. claims were issued on a first action), that Recapture does not apply. Particularly, it was pointed out in the rejection that Appellant's failure to respond to Examiner's Reasons for Allowance in paper #3 of the parent application is evidence enough for surrendering the subject matter referred to therein. Furthermore, Examiner references MPEP 1412.02 (which Appellant acknowledges on line 21 of page 9 in Appellant's brief) to support Examiner's position with respect to Appellant's failure to respond to Examiner's Reasons for Allowance.

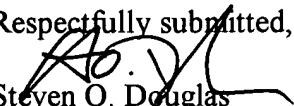
Furthermore, Appellant states that the provisions of MPEP 1412.02 are overly broad and inflexible and that the application of the provisions in this case is to the contrary, since the error (i.e. Appellant's failure to appreciate the full scope of the invention) occurred after Examiner's Reasons for Allowance and ultimately after the issuance of the Patent (see page 10, line 3 through page 12, line 12 of Appellant's brief). Although Examiner acknowledges the timing of the error occurred after the issuance of the patent, Examiner believes that this is not reason enough to waive the provisions set forth in the **RECAPTURE** doctrine.

Accordingly, the rejection is hereby deemed proper.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Steven O. Douglas

Primary Examiner

Art Unit 3751

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May 22, 2003

Conferees

SD 

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LS

MB 

MCAFEE & TAFT  
TENTH FLOOR, TWO LEADERSHIP SQUARE  
211 NORTH ROBINSON  
OKLAHOMA CITY, OK 73102